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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,335	09/24/2001	Kenneth A. Klarfeld	MNI010003	2141

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Robert D. Shedd, Patent Operations  
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EXAMINER
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BROWN, RUEBEN M

ART UNIT	PAPER NUMBER
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2424

NOTIFICATION DATE	DELIVERY MODE
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09/19/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 09/963,335	<b>Applicant(s)</b> KLARFELD ET AL.	
	<b>Examiner</b> REUBEN BROWN	<b>Art Unit</b> 2424	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 6/30/11.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 6/30/2011 have been fully considered but they are not persuasive. Applicant's argument throughout the response that Herz or Ellis or Williams do not recite the claimed subject matter. In response, it is pointed out that rejection relies on the combination of references, as discussed below.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 20-42 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention.

Considering claim 20, while the claim recites a series of steps or acts to be performed, the instant claim is not considered statutory. Based upon considerations of all of the relevant

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factors with the respect to the claim as a whole, claim is held to recite an abstract idea, and is therefore rejected as being ineligible subject matter under 35 U.S.C. 101. See, Interim Guidelines for Determining Subject Matter Eligibility for Process Claims in view of *Bilski vs. Kappos*, hereinafter referred to as Interim Bilski Guidance; See Federal Register/Vol. 75, No. 143/Tuesday, July 27, 2010; see pages 43923-43928. The rationale for this finding is explained below.

For example, claim 20 recites, '*processing information indicative of preferences of the viewer to develop a viewer characteristics profile...*', which may be performed by a person who reviews information regarding the viewing history of particular viewer and as a result selects a profile that corresponds with the instant viewing history;

*'storing viewer characteristics information on a storage device'*, is broad enough to read on the person writing the instant characteristics information on a piece of paper; *'presenting the viewer with a first list of TV programs...*', reads on the person showing the viewer a piece of paper that has a list of TV programs, arranged according to the viewer's characteristics information;

*'receiving feedback input from the viewer'*, reads on the viewer selecting one of the TV programs on the first list **or** writing a comment regarding the list and/or a particular program on the list **or** not selecting any of the programs on the list;

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*'selecting via a statistical algorithm, an alternative profile...'*, reads on the person using a mathematical formula that includes the feedback of the viewer to determine a different profile from the original profile of the viewer; and *'presenting the viewer with a second list in response to the feedback...'*, similar to the above presenting step, the additional presenting step also reads on the person showing the viewer a piece of paper that has a list of TV programs, arranged according to the alternate profile.

In view of the above analysis, examiner asserts that as a threshold matter, the claim fails the threshold M&T test. Examiner recognizes though, that the M&T test is not the only way for determining whether the claim is statutory under 35 U.S.C. 101. In particular, it is pointed out that the claimed steps are directed to either a mental activity or human behavior, both of which can be performed by a person and are considered general concepts. Use of the concept, as expressed in the method, would effectively grant a monopoly over the concept.

Considering claims 28 & 32, the claimed method includes method steps similar to the steps discussed with respect to claim 20 and is likewise treated. Considering claims 21-27, 29-31 & 33-42, the instant claims depend from claims rejected under 35 U.S.C 101, and do not add any elements that would overcome the instant rejections.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 20-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, independent claims 20, 28 & 32 recite, '*selecting, via a statistical algorithm, an alternative profile...*'. In reviewing the attendant specification, examiner finds that Para [0018] discloses, "receiving the input from the viewer... and presenting the viewer with a list of alternate TV programs... the alternate TV programs selected in accordance with an alternate profile". However, this disclosure does not cover the claimed, '*statistical algorithm...*'.

It is noted that Para [3293-3294] discusses a random selection of profiles.

It is also noted that original claim 27 recites, '*comprising randomly selecting the alternate profile from a plurality of alternative profiles*'. However, again randomly selecting does not cover a '*statistical algorithm...*', because, by definition a random selection would not use any mathematical formula to choose the selection, instead random is the opposite of calculating the outcome.

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Examiner does not find any support in the specification for the newly claimed feature, *'selecting, via a statistical algorithm, an alternative profile...'*.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 20-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Herz, (U.S. Pat # 5,758,257), in view of Williams, (U.S. Pat # 5,945,988) and Ellis, (U.S. Pat # 6,898,762).

Considering amended claims 20 & 28, the instant claims are analyzed as best understood, in light of the above 112 1<sup>st</sup> paragraph rejection. The claimed amended claimed method of displaying a TV program to a viewer, comprising *'processing information indicative of preferences of the viewer to develop a viewer characteristic information profile for the viewer'* is met by Herz, col. 10, lines 6-55; col. 11, lines 15-65 thru col. 12, lines 1-55; col. 14, lines 10-65, col. 15, lines 10-60.

*'Storing the viewer characteristics information profile on a viewer storage device'*, is met by col. 40, lines 21-65; col. 41, lines 1-15; col. 45, lines 9-30. *'Presenting the viewer with a first list of TV programs available for viewing, the programs selected in accordance with the characteristics information profile'*, is met by Herz, col. 23, lines 1-18 & col. 25, lines 49-67, which teaches virtual channels of recommended programs or highlighting recommended programs on an EPG or re-ordering the list of programs on the EPG, based on the instant customer's profile.

Regarding the amended claimed feature of *'receiving feedback input from the viewer after viewing the first list, the input requesting different selections than presented in the first list'*; Herz discloses that the system determines if the customer actually watched the video programs that were recommended by the agreement matrix, col. 26, lines 51-67; col. 31, lines 5-14; col. 46, lines 42-49, for the purpose of adjusting the agreement matrix of a particular customer.

If the customer did not select/watch the predicted program(s), then the system adjusts the customer's profile, based on what program(s) was actually watched. Therefore the disclosure of Herz, reads on the claimed subject matter, since after the agreement matrix is updated, then the customer would be given an updated/adjusted (i.e., different) list of recommended programs, in light of what was actually requested by the customer, see col. 27, lines 1-6; col. 41, lines 8-14; col. 41, lines 57-63.



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As for the amended feature, *'wherein the viewer characteristics information profile and the alternative characteristics information profile coexist and the first list and the second list remain available to the viewer'*, Herz does not explicitly teach such a feature. Nevertheless Ellis, which is in the same field of endeavor, teaches an interactive EPG that presents customized lists of programs based one or more customer profiles, col. 14, lines 11-36; col. 20, lines 17-67. Ellis furthermore teaches that the user may insert and use multiple profiles. In particular the multiple profiles may be active at the same time, col. 15; col. 16, Fig. 14. It would have been obvious for one ordinary skill in the art at the time the invention was made to modify Herz with Ellis, at least in order to allow the user have more than one active profile.

Ellis reads on the claimed subject matter because the reference clearly teaches that not only can the user activate different profiles, such as profile #1-profile #x; but also once the user is presented with a list of recommended programs based on the settings of the active profile(s), see Fig. 15 & Fig. 16a, later the instant user can change one or more of the setting(s) of the active profile(s), which will then present a different set of programs based on the current settings, see Fig. 16b-16c; col. 16, lines 34-61. All of these profiles coexist and remain available to the user, since these profiles can be saved, via the save agent 147 shown on Figs.13a-13f, col. 13, lines 27-55.

As for the additionally amended claimed feature, *'receiving feedback input from the viewer, after viewing the first list, and in response to the viewer answering a query... the feedback input requesting different inputs than the first'*, the subject matter reads on the

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subscriber in Williams (col. 11, lines 20-67 thru col. 12, lines 1-15) foregoing any selection from the recommended list, but instead choosing a different program, which then causes the associated profile/preference to be updated. These selections correspond with feedback.

*‘selecting, via a statistical algorithm, an alternative profile in response to the feedback input, the alternative profile and viewer characteristics information profile both existing at the time the viewer provides the feedback input’*, still reads on the combination of Herz, Williams & Ellis, since in both Herz (col. 4, lines 31-65; col. 26, lines 21-50) & Williams (col. 9) the profile that is chosen to be the active profile done based on a mathematical calculation that determines which profile is most similar to the viewing history of the current TV pattern. Therefore, any additional changes to the current TV watching pattern would likewise require similar re-calculation to determine if the current profile is most similar or if another known profile would be most similar.

As for *‘presenting the viewer with a second list, in response to feedback input requesting different selections, different than in the first’*, including alternative TV programs for viewing, *the alternative list selected in accordance with an alternative characteristics information profile’* for presenting the viewer with a second list, in response to the feedback, still reads on the combination since the viewer in Williams is given a second list of recommended programs based on the feedback, see (Fig. 3; Fig. 4; col. 11, lines 21-60). If the viewer in Williams decides not to view or record any of the shows, then the system continues to monitor the viewing habits of the viewer and will subsequently provide a different list of programs, which is feedback. Thus

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Williams teaches presenting a second list of programs based on feedback from a viewer, from answering a query.

In an example, in Williams the system will monitor the habits of viewer for a certain period of time, and based on the history suggest user profile, along with the associated programming, col. 9, lines 64-67 thru col. 10, lines 1-25. The user is explicitly prompted with the question as to whether the user profile selected by the system, is in fact the correct user profile for the person currently using the system. If the wrong profile is selected, then the system will likely make ineffective listings of recommended programs. Therefore the system takes feedback from the user, via a query, in order to provide programming that is most desirable to the instant user.

Considering claim 21, the claimed subject matter is met by Herz, col. 29, lines 1-26.

Considering claim 22, the claimed subject matter is met by Herz, col. 26, lines 21-50, which teaches that a plurality of profiles for different viewer may be stored at the STB.

Considering claims 23-27, Herz meets all subject matter, col. 17, lines 35-65; col. 23, lines 1-15; col. 26, lines 5-65; col. 46, lines 1-20.

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Considering claims 29-31, see Herz, col. 26, lines 1-21; col. 29, lines 1-25; col. 29, lines 30-65 & col 45, lines 20-65; col. 49, lines 1-10.

Considering claim 32, the claimed method for presenting TV programs to a viewer, comprises steps that correspond with subject matter mentioned above in the rejection of claim 20, and is likewise treated. As for the additional feature, of the '*first list arranged without viewer input*', in Herz the arrangement of the virtual lists are without user input, col. 45, lines 35-45.

Considering claim 33, the claimed subject matter reads on the user in Herz manually selecting a different program, not on the recommended list of programs using a remote control device, such as remote control device 1008, see col. 46, lines 42-60; Fig. 10.

Considering claim 34, by definition, at least some of the programs presented to the customer in Herz, based on an agreement matrix re-calculated as a result of an adjusted customer profile, would be different from the first list of recommended programs, as long as the programs that were actually watched by the customer had content attributes different from the content attributes of the programs in the first recommended list of programs.

Considering claim 35, since Ellis teaches that each profile may be saved, via save agent 147, each corresponding list would necessarily remain available to the user, see Figs. 9a-9b; Fig. 11; Figs.13a-13f; col. 13, lines 25-55.

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Considering claim 36, the second list in Williams is unrelated to the first list, as to the extent that the viewer's profiles & preferences change due to a different or unrelated viewing history.

Considering claim 37, in Ellis the viewer is enabled to activate a particular profile, from a plurality of profiles, i.e., '*alternative available lists*', which will then display a particular set of recommended programs.

Considering claims 38-42, Ellis teaches all subject matter, see col. 15, lines 1-28; col. 15, lines 55-64; col. 16, lines 15-61; col. 19, lines 45-62; col. 20, lines 17-59; col. 23, lines 51-60.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to REUBEN BROWN whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F(8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pankaj Kumar can be reached on (571) 272-3011. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Reuben M. Brown/  
Patent Examiner, Art Unit 2424